

52. (New) The method as recited in claim 46 wherein the step of applying the overlamine film layer comprises pressure laminating the overlamine film layer to the prelamine pressure-sensitive adhesive construction.

53. (New) The method as recited in claim 46 wherein, before the step of pressure laminating, treating the overlamine film to provide a tacky surface for interfacing with the prelamine pressure-sensitive adhesive construction.

54. (New) The method as recited in claim 46 further comprising, after the step of applying the overlamine film, converting the pressure-sensitive adhesive construction comprising the steps of:

cutting the pressure-sensitive adhesive construction into a desired configuration; and  
stripping away a portion of the cut pressure-sensitive adhesive construction.

55. (New) The method as recited in claim 54 wherein the step of converting is performed by die cutting and matrix stripping technique.

56. (New) The method as recited in claim 44 wherein the step of converting is performed separately from the step of forming the pressure-sensitive adhesive construction.

REMARKS

Applicants have added new claims 42 to 56. Accordingly, claims 38 to 56 are now pending in the above-identified patent application. Applicants address each and every point raised by the Examiner in the above-identified Office action as follows:

I. Claims Rejected Under Section 103

Claims 38 to 41 have been rejected under 35. U.S.C. §103 as being allegedly unpatentable over Samonides in view of McNaul. Applicants' independent claim 1 recites the method step of simultaneously applying a pressure-sensitive adhesive and a film-forming material to form the construction. A feature of Applicants' claim invention is the formation of a pressure-sensitive construction using a non-preformed pressure-sensitive adhesive material, whereby the pressure-sensitive adhesive material is applied in solvent, emulsion, or hot melt form that later cures to form a desired pressure-sensitive adhesive layer. As recited in claim 1, the step of applying the pressure-sensitive adhesive can be carried out at the same time that the film-forming material is applied.

As noted by the Examiner, Samonides fails to disclose or even remotely suggest the concept of placing a film-forming material over the pressure-sensitive adhesive material, yet alone doing this step simultaneously with forming the pressure-sensitive adhesive layer. The Examiner notes that McNaul discloses using a printable film between a printed indicia and an adhesive surface. While McNaul does disclose a printable laminate construction, it fails to disclose or remotely suggest a method of making a pressure-sensitive adhesive construction as recited in Applicants' claim 38 for the following reason.

McNaul relies on the use of *preformed* assembly members, e.g., plastic film, application tape, and carrier tape, to form its construction and fails completely to discuss any method that involves even the step of forming a pressure-sensitive adhesive layer from applying pressure-sensitive materials. Thus, despite the fact that McNaul makes use of a plastic film material, it neither discloses nor remotely suggests the invention concept of applying this material in concert with applying a non-preformed pressure-sensitive adhesive material to form the construction. Rather, McNaul simply joints a

plastic sheet with a preformed application table that comprises a pressure-sensitive adhesive layer.

Because both Samonides and McNaul each fail to disclose the concept of applying a film-forming material onto a non-preformed pressure-sensitive adhesive, the combination of these two references cannot properly operate to render obvious a method of making that is missing in each. For this reason, Applicants submit that one having ordinary skill in the art would not find Applicants' method as recited in claim 38 to be obvious in view of the combined teachings of Samonides and McNaul. In view thereof, Applicants respectfully request that the rejection of independent claim 38, and claims 39 to 41 depending therefrom, under 35. U.S.C. §103 be reconsidered and withdrawn.

II. Rejection of Claims under Section 35 U.S.C. § 112

Claim 38 has been rejected under 35 U.S.C. §112, second paragraph. Applicants have amended claim 38 to address the issue of no alleged antecedent basis, and respectfully request that the rejection of claim 38 under 35. U.S.C. §112 be reconsidered and withdrawn.

III. New Claims

Applicants have provided new claims 42 to 56. Applicants submit that the subject matter of these claims are well supported in the specification, and that the claims recite subject matter that is properly patentable over the cited art of record. In view thereof, Applicants respectfully request that these new claims be entered and allowed.

IV. Conclusion

Applicants respectfully request that the rejections of the claims under 35. U.S.C. §§103 and 35 U.S.C. § 112 be reconsidered and

Application No. 09/925,836

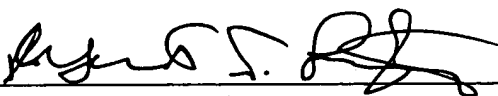
withdrawn, that new claims 42 to 56 be entered, and that claims 38 to 56 pending in this patent application be passed to allowance.

Attached hereto is a marked-up version of the changes made to the above-identified application by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By



Grant T. Langton

Reg. No. 39,739

626/795-9900

GTL/mac

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend claim 38 as follows:

38. (Amended) A method for forming a pressure-sensitive adhesive construction comprising the steps of:

applying a layer of pressure-sensitive adhesive to a release surface of a removable substrate;

simultaneously applying a film-forming material onto a surface of the pressure-sensitive adhesive layer to form a continuous film thereover and render the pressure-sensitive adhesive tack free, wherein the film-forming material has a viscosity that is within a range of viscosities that is compatible with the viscosity of the pressure-sensitive adhesive at a shear rate of approximately 40,000 s<sup>-1</sup> and at a given application temperature;

laminating an overlamine film layer onto the continuous film [prelamine construction]; and

forming a printed indicia onto one of the continuous film or a backside surface of the overlamine film layer adjacent the continuous film.